

REMARKS

In the Office Action mailed November 11, 2001, restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-17, drawn to an apparatus for total reflection x-ray reflection, classified in class 378, subclass 45.
- II. Claims 18-24, drawn to a method of using an apparatus for total reflect on x-ray reflection, classified in class 378, subclass 45.
- III. Claims 25-31, drawn to an apparatus for diffracting x-rays, classified in class 378, subclass 70.
- IV. Claims 32-40, drawn to an apparatus for total reflection x-ray reflection , classified in class 378, subclass 82.

In response to this Restriction Requirement, the Applicant hereby provisionally elects Group I, claims 1-17, for prosecution at this time. New claims 41-48 are dependent upon the claims of Group I and the applicant requests that these new claims be examined together with the claims of Group I. New claims 41-48 are based upon the original claims 32-40 and bases for these claims are clearly found in the specification.

In addition, the Applicant respectfully draws the attention of the Patent Office to the subject matter of non-elected Group II, which are classified in the same class 378 and subclass 45 of Group I. The Applicant requests that the claims of Group II also be examined with the claims of Group I. The Patent Office is respectfully reminded that one of the requirements for a restriction to be proper is that there must be a burden on the Patent Office to examine the claims together. If there is no burden, then restriction, regardless of the content of the claims, is not proper. (See M.P.E.P. §803.) In this case, the apparatus claims of Group I and the method claims of Group II are identified as being in the same class and subclass (class 378, subclass 45). It is unclear to the Applicant how the inventions of Groups I through II can be in the same class and

**Chen**  
**Serial No. 09/667,966**

subclass and still pose a burden on the Patent Office to examine. The Applicant submits that by the common designation of class/subclass alone, the Restriction of the claims of Group I from the claims of Group II is improper. The Applicant respectfully requests that the claims of Group II be examined with the elected claims of Group I.

The above provisional election of Group I claims 1-17 in compliance with 35 U.S.C. §121 is made without prejudice to the non-elected claims. An action on the merits of these claims and a Notice of Allowance therefore, are respectfully requested.

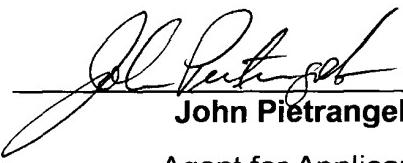
The present application is believed to be in allowable form. Early passage of the subject application to issue is earnestly solicited.

Should any small matters remain outstanding it is requested that the undersigned agent be given a call so that such matters may be worked out and the application placed in condition for allowance without the necessity of another Action and amendment.

Respectfully submitted,

**HESLIN ROTHENBERG FARLEY & MESITI P.C.**

By:

  
**John Pietrangelo**

Agent for Applicants  
Reg. No. 39,331

**JP:tap**  
5 Columbia Circle  
Albany, New York 12203  
Telephone: (518) 452-5600  
Facsimile: (518) 452-5579